<u>REMARKS</u>

Special Status

Applicant draws attention to the pendency of this application, which is now greater than five years. Accordingly, under MPEP 708.01(I), this application is now entitled to "special" status.

SECTION 103 REJECTION OF CLAIM 1

The cited art

Mondrosch,[1] describes "[s]elective call signaling systems (e.g., paging systems)" that "provide one-way radio-frequency (RF) communication of selective call messages to a selective call receiver."[2]

The "selective call receiver" of *Mondrosch* is thus another name for a telephone pager, or "beeper." Such devices were in widespread used before cellular telephones rendered them obsolete. These pagers would beep when one called a designated telephone number. The person beeped would then look at the pager's display to see the calling telephone number, and in some cases, a short message. This message would then be saved, together with other messages, in a message list on the pager itself.

Tugenberg discloses a computer network in which various "stations" send messages to each other. One of these stations acts as a network controller, or supervising station. *Tugenberg* teaches a method for ensuring that each station knows which station acts as the network controller.

No motivation to combine the references

The Examiner agrees that *Mondrosch* fails to disclose:

"modifying said new-message slot to specify an intended recipient"

---

[1] *Mondrosch*, et al., U.S. Patent No. 5,379,031.
[2] *Mondrosch*, col. 1, lines 13-15.

The Examiner suggests, however, that this limitation can be found in *Tugenberg*,[3] and in particular, at col. 4, lines 15-20 and lines 34-46. The Examiner then proposes to combine *Mondrosch* and *Tugenberg* because one of ordinary skill in the art

> "would have found it obvious to implement or incorporate *Tug's* modifying said new-message slot to specify an intended recipient in *Mond's* method in order for receiving stations to decide whether to discard or accept a received message."[4]

However, one of ordinary skill in the art would surely have recognized that once a message is placed in the message list of the *Mondrosch* pager, it has *already reached* its intended destination. Thus, one of ordinary skill in the art would no doubt find it unnecessary to modify a message slot to specify an intended destination of a message *after that message has already arrived* at its intended destination. Indeed, one of ordinary skill in the art would recognize such an exercise as being about as pointless as retrieving an envelope from one's mailbox, and then writing one's address on the envelope.

Where the references do not expressly or impliedly suggests the claimed invention, "the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."[5]

Applicant requests that the Examiner provide some plausible chain of technical reasoning to explain why one of ordinary skill in the art would bother to specify an intended recipient of a message when that *message has already arrived* at its intended recipient.

Tugenberg fails to teach missing claim limitation

It is unclear what, in *Tugenberg*, the Examiner regards as corresponding to the claimed message list, or what in *Tugenberg* corresponds to a new-message slot that is to be modified.

---

[3] *Tugenberg*, et al., U.S. Patent No. 5,335,281.
[4] *Office Action*, page 3.
[5] *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985).

Nevertheless, the Examiner draws attention to five fields **210, 215, 220, 225, 280** (see FIG. 2) that allegedly contain certain identification information. These fields are part of a message header **205**, and not part of a message list with message slots.

According to the Examiner, information in these five fields is

> "used by other processors to determine whether a particular processor should accept or discard the message."[6]

However, *Tugenberg* is cited for its alleged disclosure of "*modifying* said new-message slot to specify an intended recipient." The fact that *Tugenberg* happens to *use* certain information stored in certain fields to decide whether to accept or reject a message is irrelevant to modifying a slot to specify an intended recipient.

Moreover, there is no teaching in *Tugenberg* that information in any one of those five fields specifies an intended recipient. In particular:

- The first field **210** includes information identifying a type or purpose of a message. This field therefore lacks information specifying an intended recipient as required by the claim. [7]

- The second field **215** includes information identifying the particular station that a sending station characterizes as being the network controller. This has nothing to do with specifying an intended recipient as required by the claim. [8]

- The third field **220** includes information indicating whether a sending station or a receiving station has been most recently updated. Again, this has nothing to do with specifying an intended recipient as required by claim 1.[9]

[6] *Office Action*, page 4.
[7] *Tugenberg*, col. 3, lines 45-50, col. 5, lines 54-56.
[8] *Tugenberg*, col. 3, lines 51-53, col. 5, lines 56-58.
[9] *Tugenberg*, col. 3, lines 54-61; col. 5, lines 60-61.

- The fourth field **225** identifies the sending station, not the receiving station. This field therefore has nothing to do with specifying an intended *recipient* as required by claim 1.[10]

- The fifth field **230** contains the message itself. Again, this has nothing to do with specifying an intended recipient of the message.[11]

It is apparent that none of the five fields have anything to do with specifying an intended recipient. It is therefore difficult to see why modifying any of these fields would somehow specify an intended recipient of the message as required by claim 1.

Claim requires message list accessible to a plurality of processors

The preamble of claim 1 recites a method for posting a message on "a message list *accessible to a plurality of processors*." The message list in *Mondrosch* cannot be accessed by a plurality of processors. Therefore, *Mondrosch* is not even pertinent to the claimed invention.

Claim 1's preamble recites a structural limitation on the message list. It is, in fact, precisely the message list's accessibility to processors that permits one processor to place a message in a new-message slot and another processor to receive that message. If the message list were only accessible to a single processor, as is the case in *Mondrosch*, it would make no sense for one processor to post a message for another processor. After all, that other processor would never be able to access the message list to see the message.

Applicant draws attention to *Corning Glass Works*[12] in support of the proposition that any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.

---

[10] *Tugenberg*, col. 4, lines 62-64; col. 5, lines 62-63.
[11] *Tugenberg*, col. 4, lines 65-68; col. 6, lines 1-10.
[12] *Corning Glass Works v. Sumitomo Electric*, 861 F.2d 1251, 1257 (Fed. Cir. 1989).

Tugenberg does not appear to teach modifying any message list. Hence, the proposed combination of the two references fails to teach "a message list accessible to a plurality of processors."

The remaining claims are dependent on claim 1 and are therefore patentable for at least the reasons discussed in connection with claim 1.

Dependent Claims

With regard to the dependent claims, applicant incoporates and re-asserts the arguments set forth in the response filed on March 23, 2006.

Section 103 rejection of claims 5, 6, 8, and 9

The Examiner has raised new grounds for rejecting claims 5, 6, 8, and 9, all of which recite limitations that refer to either destination masks or attention masks.

The Examiner concedes that *Mondrosch* fails to teach either destination masks or attention masks. However, the Examiner seems to be suggesting that the five fields shown in FIG. 2 of *Tugenberg* are both destination masks and attention masks.

The Examiner does not explain why any of the five fields shown in FIG. 2 should be regarded as either an attention mask or a destination mask. Instead, the Examiner appears to have simply cut and paste text from the rejection of claim 1. This recycled text states that the five fields contain information that is

"used by other processors to determine whether a particular processor should accept or discard the message."[13]

The Examiner declines to explain just how *Tugenberg's* use of certain information to determine whether a processor should accept or discard a message establishes the existence of both destination masks and attention masks.

---

[13] *Office Action*, page 4.

Applicant requests that the Examiner quote verbatim that portion of *Tugenberg* that teaches destination masks and/or attention masks.

Summary

Now pending in this application are claims 1-9, of which claim 1 is independent.

That Applicant has argued only certain grounds for patentability is not meant as an admission that no other grounds for patentability exist, either for those claims specifically discussed, or those claims that were not discussed.

Enclosed is a Petition for Extension of Time together with authorization to charge the fee to our deposit account. No additional fees are believed to be due in connection with the filing of this response. However, to the extent fees are due, or if a refund is forthcoming, please adjust our deposit account 06-1050, referencing attorney docket "07072-127001."

Respectfully submitted,

Date: _March 23, 2003_

Faustino A. Lichauco
Reg. No. 41,942

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

21590785.doc